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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,277	07/09/2001	Osamu Nagata	7217/64520	7556

7590 09/11/2002

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 09/11/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,277

Applicant(s)

NAGATA ET AL.

Examiner

Aristotelis M Psitos

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2653

DETAILED ACTION

Applicants' response of 8/12/02 has been considered with the following results.

Applicants have elected without traverse the invention of Group I (claims 1-3) as indicated in the previous Office action. Applicants have canceled the remaining pending claims in the application.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The examiner recommends some title with the special character "/" to denote the inventive claimed feature with respect to the "separating information".

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2653

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hui.

Hui discloses a record medium having two "management" data areas; the index file and the directory file – note such descriptors in figure 2.

With respect to the ability of having "separating information" recorded along with the second management data, the examiner interprets such as being nothing more than the well know ability of "delimiters" – see the attached definition of delimiters in the Dictionary of Computers, Information Processing & Telecommunications (2nd Edition) for instance.

The use of such delimiters is part and parcel of ASCII code and the use thereof is commonplace, i.e., use of such a code to writ information onto the disc.

With respect to the limitations of claim 2, portioning information, again, use of such information for subdividing a large block of information into smaller blocks is also part and parcel of encoding the files on the record medium, and the use thereof is common place, such as frame #s, file #s, track #s, etc.

Under 102 considerations the examiner considers Hui to inherently posses the above claimed

Art Unit: 2653

"separating data" (claim 1) and "partitioning data" (claim 2).

With respect to claim 3, using identifiers such as "names" in the management data field is also considered commonplace in this environment.

If applicants can convince the examiner that such information (separating, partitioning, names) etc. are not inherently present, then under 103 considerations, the examiner would consider the use of having such would be obvious to those of Ordinary skill in the art, motivation is to use COMMON KNOWN techniques such as ASCII codes for writing, separating, identifying information found on blank discs.

7. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Takaku et al.

With respect to claim 1, the first and second data management areas are interpreted as the either the PTOC and UTOC Information and the "separating data" is interpreted as the special code "^" as described in col. 13 line 5 plus.

With respect to claims 2 and 3, note that portioning data, such as track #s, etc. are contained therein, and with respect to the "names" note that the system allows the user to "name" his selected information.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kajiyama et al.

Kajiyama et al discloses a disc having management data and secondary management data, see the discussion with respect to the TOC and the names of albums etc. – col. 8 lines 51 plus.

With respect to the claimed "separating data" claim 1, because the information is written in ASCII code (examiner assumes such) and in ASCII format the use of delimiter codes are inherently present the limitations of claim 1 are anticipated. If applicants can convince the examiner that ASCII code is not used in the Kajiyama et al system, then the examiner would assume that the code for introduction of information into the systems would be JIS, and again delimiter codes in this language is well known as well.

Similarly, partitioning codes, frame #s, file #s, track #s, are inherently present in the above system as are names.

Art Unit: 2653

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shitara et al is also cited as having two management data abilities – groups, and or sub data, while Okada et al is cited as illustrative of another two management data ability – a/v designations. Van Ryzin is cited for creating customized play lists.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



AMP
September 9, 2002